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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,263	03/04/2002	Scott C. Nance	4248P2441	4043
23504 7590 06/19/2009				
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251				
EXAMINER				
LIN, SHEW FEN				
ART UNIT		PAPER NUMBER		
2166				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3 _____
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6 _____
7 *EX PARTE* SCOTT C. NANCE
8 _____

9 Appeal 2009-001325
10 Application 10/086,263
11 Technology Center 2100
12 _____

13 Oral Hearing Held: May 20, 2009
14 _____

15 Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
16 HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

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19 APPEARANCES:

20 ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for oral hearing on Wednesday,
2 May 20, 2009, at The U.S. Patent and Trademark Office, 600 Dulany Street,
3 Alexandria, Virginia, before Laurie Allen, Notary Public.

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5 JUDGE DIXON: You may begin anytime you're ready.

6 MR. WEISS: Thank you. May it please the Court.

7 I wanted, for purposes of today's argument, to just focus on three of
8 the claims, Claims 2, 13, and 15, and I want to assure the panel that I
9 recognize the gravity of the -- even though the Examiner's answer did not
10 cite the KSR, I recognize the gravity of the KSR issue that might potentially
11 apply to these claims.

12 JUDGE BLANKENSHIP: Excuse me. Were these claims separately
13 argued in the Appeal Brief?

14 MR. WEISS: I believe they were. If I can point to page 7 of the
15 Appeal Brief, the dependent appealed claims are separately broken out at
16 page 7, and then I believe the argument touches on the claims, not in the
17 specific sections, but I believe in a way that --

18 JUDGE DIXON: That's your summary of claimed invention, not your
19 argument relative to the claim.

20 MR. WEISS: Correct. The argument itself, though, does talk about
21 the features that are in Claims 2, 13, and 15, the downloadability to cell
22 phones and PDAs, and the fact that it's an alphabetic directory.

23 JUDGE BARRY: Can you just point to us where, specifically, in
24 your Appeal Brief, that would be a big help.

1 MR. WEISS: In one place, I can show, at page 10, Shaffer teaches
2 such a database. It talks about a -- let's see -- publicly accessible, searchable
3 database, which would have to be based on alphabetical -- an alphabetical
4 listing, but let me see if I can find something better than that.

5 JUDGE BLANKENSHIP: Well, let's start with the broadest claim
6 and see where we go. Claim 21 appears to be broad.

7 MR. WEISS: Yes, Your Honor.

8 I note that the application was filed in 2002, 7 years ago. KSR in no
9 way eliminated the availability of secondary considerations of
10 non-obviousness.

11 JUDGE BLANKENSHIP: Do we have secondary considerations in
12 this case?

13 MR. WEISS: I think we perhaps have one.

14 JUDGE BLANKENSHIP: Do we have evidence of secondary
15 consideration --

16 MR. WEISS: We don't have extrinsic evidence of secondary
17 consideration. I think what we've stated in the Brief, without contravention
18 by the Examiner, is that it was filed in 2002, and still, these -- such a -- such
19 a database does not exist.

20 A searchable database by user --

21 JUDGE BLANKENSHIP: Well, that's anticipation. How is that a
22 secondary consideration?

23 MR. WEISS: Secondary consideration would be a long-felt
24 unresolved need for the invention.

25 JUDGE BLANKENSHIP: Is in the Brief?

1 MR. WEISS: Not teased out in that fashion, it is not, Your Honor, but
2 what is in the Brief is the statement, again un-rebutted by the Examiner,
3 that -- that this database does not yet exist, and again, it was -- it was an
4 application filed 7 years ago, in 2002, and if, in fact, it would be obvious to
5 do this -- and of course, cell phones, if anything, have only increased in
6 popularity since 2002. Increasingly, people are shedding their land lines and
7 going exclusively to cell phones. This ought to exist now, and yet it does
8 not.

9 JUDGE BARRY: On that note, people that have cell phones, like
10 my -- like my brother and his wife, in New York, instead of land lines, tell
11 me one of the big advantages is they're not in a directory, so they don't get
12 telemarketers. Isn't your client's invention going to take away that
13 advantage?

14 MR. WEISS: I think that's -- that's a potential issue. Ultimately, I
15 think there's going to have to be directories, because as people increasingly
16 move to a cell-phone-based system, I do think people need to have access to
17 directories, and perhaps a do-not-call registry or things of that nature can
18 address the telemarketing issue, which is, I think, a real issue.

19 JUDGE BLANKENSHIP: Back to Claim 21, how does Claim 21
20 distinguish over Smith?

21 MR. WEISS: Smith does not disclose the compilation of a list of
22 cellular phone numbers. It just discloses the compilation of a list of phone
23 numbers.

1 JUDGE DIXON: How is a cellular phone number different than a
2 normal, regular cell phone number? I mean the data. It's just a database of
3 telephone numbers. Is a cellular phone number different?

4 JUDGE BLANKENSHIP: Ten digits.

5 MR. WEISS: It's also 10 digits. I think the Shaffer reference itself
6 actually does note that cell numbers are different in the sense that the first
7 three numbers, the NPA code, the area code -- that would essentially be the
8 same whether it's a cell phone or a -- or a land-based phone.

9 The next three numbers -- I believe they're called -- they're referred to
10 as the NXX numbers. Those actually -- for a land-based number, they are
11 suggestive, I believe, or indicative of a particular geographic area, where
12 that's not the case with cell phones.

13 JUDGE DIXON: I would say they're suggestive, maybe, but you can
14 buy a Baltimore number in the Washington area, get a local Baltimore
15 account, so that you don't have to pay long-distance when long-distance was
16 a concern, but that's been around for years, that you can buy the other area
17 codes. They just charged you more.

18 MR. WEISS: That's correct, but I also think that that points to one of
19 the distinctions, which is that if you go to your local white pages for your
20 land-based phone, those are -- those are organized by -- typically, by area
21 code, whereas to compile a cell phone listing, you actually would have to do
22 it, presumably, in a different fashion, because you wouldn't just do it for
23 Baltimore County or Montgomery County or Arlington County or
24 something like that, on a geographic basis, but instead would want to do --

1 JUDGE DIXON: But the claim doesn't set forth how you're
2 compiling. It just says you're compiling. You could do it however you
3 want.

4 MR. WEISS: Correct.

5 JUDGE DIXON: It would be a choice of the designer, whoever is
6 designing it, and land-based is dictated by the telephone company, generally,
7 as to how they did it, for whatever reason they did it, probably, for writing
8 the phone book that they would normally write.

9 MR. WEISS: That's correct, Your Honor. Other than in Claim 2, it
10 specifies that it should be an alphabetic directory, in Claim 8 it specifies that
11 it should be 2 or more cell phone providers.

12 JUDGE DIXON: So, you're saying that alphabetic would
13 be -- distinguish this invention somehow, that it's -- but the phone book has
14 been alphabetic since, probably, its inception, and then -- business for
15 yellow pages. What's the distinction?

16 MR. WEISS: I recognize that if -- if Claim 1 is found to be obvious, I
17 don't truly think that there is a meaningful independent argument that
18 because we've made it an alphabetic directory, we have perhaps not
19 overcome obviousness for Claim 1 but we have for Claim 2, and in that
20 sense, I think the Brief properly does not spend a great deal of time teasing
21 out the -- the individual claims, but I think that, with respect to the art that's
22 been cited, you know, again, Smith only talks about land-based directories,
23 and the Shaffer reference, in our view, is dealing with something entirely
24 different, which is a computerized system used by -- by a service to allow
25 them to look up phone numbers, and from the phone numbers to then obtain

1 information about the geographic location of a person who has called into a
2 calling system using what they call a vanity line, like a 1-800-Florida, is the
3 example that they give, and that's not truly the situation, and again, I think
4 the examiner, in our view, in truly rendering this obvious, I think perhaps the
5 Examiner's more meaningful arguments are just the broader ones that, in the
6 Examiner's view, there is no distinction between wireless and a land-based
7 directory type of service.

8 We disagree with that. We point to the long-felt need, we point to the
9 2002 filing date, and I think that's our position.

10 Thank you very much.

11 JUDGE DIXON: Thank you.

12 (Whereupon, the proceedings were concluded on May 20, 2009.)